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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,899	12/21/2000	Jyh-Yuan Deng	MSV002	6284

7590 09/11/2003

NAIPO (North America International Patent Office)  
P.O. Box 506  
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EXAMINER

MAHMOUDI, HASSAN

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/740,899

Applicant(s)

DENG, JYH-YUAN

Examiner

Tony Mahmoudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DOV POPOVICI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

## DETAILED ACTION

### *Remarks*

1. The applicant uses the term "electrical document" throughout the specification and the claims of the disclosure. It is recommended that the term "electrical document" be changed to --electronic document-- in order to differentiate this recitation from "documents written on electrical objects".

### *Specification*

2. The abstract of the disclosure is objected to because it contains more than 150 words. The abstract should be edited to contain no more than 150 words. Correction is required.
3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "aid," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. See MPEP §608.01(b).

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. See MPEP §608.01(b).

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9-12 recite the limitation "the method" in line 1. There is insufficient antecedent basis for these limitations in the claim. Correction is required.

Claim 10 is further rejected under 35 U.S.C. 112, second paragraph, as being dependent from rejected dependent claim 9.

Claim 12 is further rejected under 35 U.S.C. 112, second paragraph, as being dependent from rejected dependent claim 11.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in

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- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al (U.S. Pub. No. 2003/0088784.)

As to claim 1, Ginter et al teaches a method (see Abstract) used in network, comprising a server connected with a plurality of terminals (see page 35, paragraphs 479 and 481) that can request the server to rent an electrical document for a specific period of time (see page 14, paragraph 194) and the server storing the electrical document to a storage device of the terminal (see page 15, paragraph 197, and see page 19, paragraph 217), for controlling the termination date of electrical documents (see page 79, paragraph 1169, and see page 169, paragraph 2290) comprising the following steps:

users loading an application program in the terminal to set a specific storing position for the electrical document (see page 15, paragraph 199);

the server encrypting the current date, the termination date (see page 169, paragraph 2290), and plaintext of the electrical document to a corresponding ciphertext (see page 112, paragraph 1588), transferring the ciphertext to the terminal, storing the ciphertext in the specific storing position of the storage device, and recording information of the storing position when the terminal requests the server to rent the electrical document (see page 122, paragraphs 1739-1749);

the application program matching whether the current storing position is the as same as the recorded storing position and deciphering the ciphertext to the original plaintext of the electrical document for users intending to read the electrical document (see page 125, paragraph 1810, where “original plaintext” is read on “decryption”);

the application program continually updating and storing the current date in the storing position during the time users read the electrical document (see page 37, paragraph 502); and

the application program examining whether the current date exceeds the termination date and denying access to the electrical document if the current date has exceeded the termination date (see page 169, paragraph 2290.)

As to claims 2 and 8, Ginter et al teaches wherein the information of the storing position is under encryption (see page 37, paragraph 499.)

As to claims 3 and 9, Ginter et al teaches wherein when the terminal requests the server to rent the electrical documents for a specific period of time (see page 72, paragraph 1097-1099), the termination date is valid if the current date has not exceeded the termination date (see page 111, paragraphs 1563-1565.)

As to claims 4 and 10, Ginter et al teaches wherein the application program informs users the electrical document is expired when the current date has exceeded the termination date (page 134, paragraphs 1893-1897.)

As to claims 5 and 11, Ginter et al teaches wherein when total reading hours exceeds a predetermined reading hours (see page 115, paragraph 1624), the application program denies access to the electrical document (see page 169, paragraph 2290.)

As to claims 6 and 12, Ginter et al teaches wherein the application program informs users the electrical document is expired (page 134, paragraphs 1893-1897) when the total reading hours (see page 115, paragraph 1624) exceeds the predetermined reading hours (see pages 22-23, paragraph 227, and see page 92, paragraph 1362.)

As to claim 7, Ginter et al teaches a network (see Abstract, and see page 35, paragraphs 479 and 481) for controlling a termination date of an electrical document (see pages 22-23, paragraph 227, and see page 92, paragraph 1362) comprising a server connected with a plurality of terminals (see page 35, paragraphs 479 and 481), each terminal comprising an application program and a storage device and the ability to request the server to rent the electrical document (see page 14, paragraph 194); the server comprising a rent control center for encrypting the current date, the termination date (see page 169, paragraph 2290), and plaintext of the electrical document to a corresponding ciphertext (see page 112, paragraph 1588), sending the ciphertext to the terminal, storing in a specific storing position of the storage device, and recording information of the storing position (see page 122, paragraphs 1739-1749); the application program comprising:

a storing position checking module for matching whether the current storing position is the same as the recorded storing position and deciphering the ciphertext to the original

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plaintext of the electrical document for users intending to read the electrical document (see page 125, paragraph 1810, where "original plaintext" is read on "decryption");

a time imprinting module for continually updating and storing the current date in the storing position during the time users read the electrical document (see page 37, paragraph 502); and

a termination date examining module for examining whether the current date exceeds the termination date and denying access to the electrical document if the current date exceeds the termination date (see page 169, paragraph 2290.)

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of art with respect to methods and systems of electrical/electronic document access control based on expiration dates in general:

Patent No.	Issued to	Cited for teaching
US Pub. No. 2002/0046350	Lordemann et al.	Object distribution and protection over a network.
US 6,430,688	Kohl et al.	On-line and off-line digital document and digital certificates.



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9. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Tony Mahmoudi whose telephone number is (703) 305-4887. The examiner can normally be reached on Mondays-Fridays from 08:00 am to 04:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici, can be reached at (703) 305-3830.

tm

September 3, 2003

  
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